

Appl. No. 10/691,716  
Amdt. dated August 8, 2005  
Reply to Office Action of May 9, 2005

Docket No. 58009-017200

### **RESPONSE TO EXAMINER'S REJECTIONS/OBJECTIONS**

The office action issued by the Examiner and the citations referred to in the office action have been carefully considered.

Claim 1 and 5 are amended with this response.

Claim 13 is newly added.

#### ***Restriction***

The Examiner has restricted Claims 11 and 12 as being a newly added method claim. However Claim 11 is not a method claim and should not be restricted. Moreover, newly added Claim 13 is not a method claim. Furthermore, Claims 11 and 13 are directed to an invention distinct from and independent of the invention previously claimed. For example, Claims 11 and 13 both recite elements, although in a different combination and in number, which are previously claimed. Thus, Applicant respectfully requests that the Examiner reinstate Claim 11.

#### ***Claim Rejections - 35 U.S.C. § 103***

The Examiner has rejected Claims 1 and 3-10 under 35 U.S.C. § 103(a) as being unpatentable over Runge (U.S. Patent No. 5,247,781) in view of Grevich et al (U.S. Patent No. 4,305,240). Examiner asserts that Runge discloses all the elements of Claims 1 and 3-10 except for the that Runge does not disclose a power-driven film feed roller designed to apply a uniform pulling force on the film which is unwound and fed into the sealing unit wherein the power driven feed roller has on its surfaces a series of jaws for transversely sealing and separating the packages. Accordingly, Examiner asserts that Grevich discloses a packaging machine comprising a power-driven film feed roller similar to the present application and that it would have been obvious to one skilled in the art to combine the teachings of Runge with Grunge to find the present invention.

#### **(i) The Runge and Grevich references when combined do not teach all the elements of the independent Claims**

The Runge and Grevich references when combined do not teach all the elements of the newly amended independent Claims 1, 5, 11, and 13 from which dependent Claims 2-4, and 6-

Appi. No. 10/691,716  
Amdt. dated August 8, 2005  
Reply to Office Action of May 9, 2005

Docket No. 58009-017200

10 depend from. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). See also, MPEP 2143.03. Specifically, the Runge and Grevich references when combined do not teach a horizontal packaging machine for making fluid-tight packages equipped with a zip closure, having a power-driven film feed roller designed to apply a **uniform pulling force** on the film which is unwound and fed into the sealing unit. In particular, the references don't teach a power driven feed roller which is located downstream from the sealing unit so that its location and uniform pulling prevent the film from being uneven while sealed. Specifically, the power-driven feed roller of Grevich is not the same element as the roller disclosed by the present application. The roller in Grevich does not apply a uniform pulling force. First, the roller in Grevich uses two jaws to grip the wrapper (see column 11, lines 8-50) and one of the jaws (35) that grips the wrapper is moving and swingable (see column 12, lines 40-56). Second, Grevich is concerned with a coordinated movement of a tubular wrapper. Grevich refers to a variable speed that is coordinated between a driving sprocket, a chain and a rotor. Column 8, Line 33. Thus, because the speed of the wrapper is coordinated with the rotor, the rotor cannot apply a uniform pulling force. Again, the wrapper is not constantly gripped and thus there is no uniform pulling force. Simply put, the roller in Grevich is not the same element as the element of the present application. Accordingly, Grevich does not teach the claimed roller.

Furthermore, with respect to Claim 13, neither Grevich or Runge teaches free turning guide rollers (30) for guiding the film which are a part of the sealing unit (20) as depicted in Figure 1 of the present application. Thus, Applicant respectfully submits that Examiner cannot establish a *prima facie* case of obviousness because the references when combined do not teach all the elements of newly amended independent Claims 1, 5, 11, and 13.

Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending there from is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also, MPEP 2143.03. Claims 2-4, and 6-10 are dependent from Claims 1, 5, 11, and 13. Therefore, because Claims 1, 5, 11, and 13 are not obvious, Claims 3-4, and 6-10 are not obvious over Runge in view of Grevich.

Appl. No. 10/691,716  
Amdt. dated August 8, 2005  
Reply to Office Action of May 9, 2005

Docket No. 58009-017200

**(ii) Both the Runge and Grevich reference lack the suggestion or motivation to combine references**

Not only do the references cited above fail to teach the elements of the present application, but the references lack the suggestion or motivation to combine references. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2403.01.

Further, requiring a motivation to combine prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of invention. *Princeton Biochemicals Inc. v. Beckman Coulter Inc.*, (Fed. Cir. 1995) 70:206.

**(a) No explicit suggestion or motivation to combine references**

As stated above, motivation must be found either explicitly and/or implicitly. With respect to an explicit showing, Applicant respectfully submits that Examiner has failed to show where or how the Grevich or Runge references contain a suggestion or motivation to combine the references. Applicant cannot find a suggestion or teaching in the claims or specification of Runge to replace the sealing bars in Runge with a power-driven feed film roller that applies a uniform pulling force on the film. Therefore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Appl. No. 10/691,716  
Amdt. dated August 8, 2005  
Reply to Office Action of May 9, 2005

Docket No. 58009-017200

**(a) No implicit suggestion or motivation to combine references**

Furthermore, the Grevich and Runge references lack an implicit suggestion or motivation to combine references. The MPEP states that, "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). See also, MPEP 2403.01.

In the present case, the nature of the problem to be solved as a whole *does not* suggest to those of ordinary skill in the art to combine the Grevich and Runge references. Although both references teach a packaging machine, neither reference suggests that including a roller which is designed to apply a uniform pulling force to prevent film from becoming uneven or wrinkled. Therefore, they cannot provide an implicit motivation or suggestion to combine these references. Thus, they cannot render the elements of independent Claims 1, 5, 11, and 13. Accordingly, Claims 3-4, and 6-10 are not obvious. Thus, Applicant respectfully requests that the Examiner also withdraw these rejections as to Claims 1 and 3-10.

Appl. No. 10/691,716  
Amdt. dated August 8, 2005  
Reply to Office Action of May 9, 2005

Docket No. 58009-017200

**REMARKS**

Applicant has complied with all requirements made in the above-referenced communication. In view of the foregoing, it is respectfully submitted that the pending Claims in the application are in condition for allowance. Allowance of the pending claims at an early date is courteously solicited.


If, for any reason, the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicant's undersigned representatives, attention Eglia Nair Flores at (310) 586-6511 to discuss the steps necessary for placing the application in condition for allowance.

One new independent claim This response is being timely filed and no extension fee is believed due. The Commissioner is hereby authorized to charge the \$100.00 fee for the additional independent claim and any required fee in connection with the submission of this paper, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that Attorney Docket Number 58009-017200 is referred to when charging any payments or credits for this case.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Date: August 8, 2005

By   
Eglia Nair Flores  
Reg. No. 54,103

Customer Number 33717  
GREENBERG TRAURIG, LLP  
2450 Colorado Avenue, Suite 400E  
Santa Monica, CA 90404  
Phone: (310) 586-6511  
Fax: (310) 586-0511